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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,454	01/31/2001	William W. Cimino	5116.01	8022

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EXAMINER

LINDSEY, RODNEY M

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 11/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/773,454

Applicant(s)

CIMINO, WILLIAM W.

Examiner

Rodney M. Lindsey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15 and 24-31, drawn to an ultrasonic applicator, classified in class 606, subclass 169.
  - II. Claims 16-23, drawn to a method of making an ultrasonic applicator, classified in class 428, subclass 336.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different product such as the scalpel of U.S. patent no. 4,981,756 to Rhandhawa.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Thomas H. Young on November 15, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-15 and 24-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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***Drawings***

5. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

***Specification***

6. The disclosure is objected to because of the following informalities: On page 3, line 2 "allows" it appears should be --alloys-- and on page 6, line 10 "Figure 1" is not understood.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6,7,10,11,14,15,29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1,8,12 and 24 the surface coating of aluminum oxide is set at a thickness of between about 0.0001 and 0.0003 inch. In contrast dependent claims 6, 10, 14 and 29 set the thickness as being between about 0.0003 and 0.0005 inch. As claims 6, 10, 14 and 29 include the limitations claims 1, 8, 12 and 24 they are therefore confusing as to the possible thickness of the aluminum oxide coating.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-15 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hood '143 in view of Rhandhawa.

Hood '143 discloses an ultrasonic applicator or knife for use by surgeons formed of a base portion of aluminum alloy (see column 7, line 49) and of a surface coating of ceramic material or aluminum oxide (see column 7, line 53). With respect to claims 1, 8, 12 and 24 Hood '143 does not teach that the aluminum oxide coating be of a thickness of between 0.0001 and 0.0003 inch. Rhandhawa teaches old and well known the use of ceramic material coatings of a thickness of from 1 to 10 microns on medical tools (see claim 3). To modify the applicator of Hood '143 such that the thickness of the aluminum oxide coat is between 0.0001 and 0.0003 inch would have been obvious since one of ordinary skill in the art of coated medical devices at the time of the invention would readily have recognized such coating thickness as being within an effective coating thickness range for providing wear resistance in the manner of the coatings of Rhandhawa. With respect to claims 2 and 25 note the blade 26 of Hood '143. With respect to claims 3 and 26 Hood '143 does not teach a lipoplasty device. However, Rhandhawa teaches

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that it is old to provide protective coatings to other medical tools (see column 1, line 30). To modify Hood '143 by providing the aluminum oxide coating on other medical tools such as a lipoplasty device would have been obvious in view of Rhandhawa since one of ordinary skill in the art at the time of the invention would readily have recognized the coating as providing a like protection to other medical tools. With respect to claims 4, 8, 12 and 27 the specific type of aluminum alloy employed by Hood '143 would have been considered an obvious matter of choice and design to one of ordinary skill in the art at the time of the invention since all that would have been required is that the particular aluminum alloy be usable under ultrasonic conditions and be compatible with the coating. With respect to claims 6, 10, 14 and 29 Rhandhawa teaches old the use of a variety of color coatings. It would have been obvious for one of ordinary skill in the art at the time of the invention to provide the coating of Hood '143 with the colorant of Rhandhawa to achieve the advantage of effecting a distinguishing color to the medical tool. With respect to claim 31 the manner in which the coating is performed is not seen to set forth a method of use step not found in Hood '143.

### ***Conclusion***

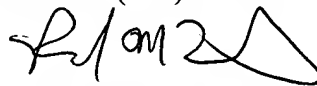
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note particularly, the coated tools of Borrkfield, Smith, Jones et al., Morris, Gorokhovsky, Hood '510 Julien and Moriguchi et al. and the anodizing in Jensen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney M. Lindsey whose telephone number is (703) 305-7818. The examiner can normally be reached on M-F (8:30-5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J. Calvert can be reached on (703) 305-1025. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9301.

A handwritten signature in black ink, appearing to read 'R/M 2' followed by a stylized flourish.

Rodney M. Lindsey  
Primary Examiner  
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rml  
November 17, 2002